

### **REMARKS/ARGUMENTS**

Prior to entry of this Amendment, claims 1, 2, 4-15 and 17-22 were pending in this application. Claims 1, 8, and 10-14 have been amended, no claims have been added, and claims 6, 9, and 19 have been canceled herein. Therefore, claims 1, 2, 4, 5, 7, 8, 10-15, 17, 18, and 20-22 remain pending in this application. The Applicants respectfully request reconsideration of this application for at least the reasons presented below.

#### **35 U.S.C. §103 Rejection, Downs in view of Ellis**

The Office Action has rejected claims 1, 2, 4-15 and 17-22 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,574,609 to Downs et al. (hereinafter “Downs”) in view of U. S. Patent No. 7,051,360 to Ellis et al. (hereinafter “Ellis”). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). However, the references relied upon by the Office Action do not teach or suggest each claimed limitation. For example, neither Downs nor Ellis, alone or in combination, teaches or suggests storing content (i.e., a video program or an audio program) at a user location before the user specifically requests the content. Furthermore, neither reference, alone or in

combination, teaches or suggests the content comprising a subset of content available from the content distributor and associated with a premium subscription service.

Downs is directed to "a system and related tools for the secure delivery and rights management of digital assets, such as print media, films, games, and music over global communications networks such as the Internet and the World Wide Web." (Col. 1, lines 63-67) Under Downs, content data and associated metadata are generated and the content data is transferred to a content host while the metadata and usage condition data for the associated content are transferred to an electronic store. (Col. 3, lines 52-56) "The metadata and/or the usage condition data are altered in order to form promotional data, and the promotional data is transferred from the electronic store to a customer's system." (Col. 3, lines 56-59) However, Downs does not teach or suggest storing the content at a user's location before the user specifically request the content. Rather, under Downs, the metadata provides information about the content that can be used by an "Electronic Digital Content Store" to form promotional data for use on its website. (Col. 17, lines 64-66 and col. 18, lines 7-14) Then,

"After the Electronic Digital Content Store(s) Web Site is up- dated, the Content is available to End-User(s) surfing the Web. When an End-User(s) finds Content that they want to buy, they click on a content icon, such as a music icon, and the item is added to his/her shopping cart which is maintained by the Electronic Digital Content Store(s). When the End-User(s) completes shopping they submit the purchase request to the Electronic Digital Content Store(s) for processing." (Col. 18, lines 13-19)

That is, under Downs, the content is downloaded to and stored at the user's location only after specifically requested, i.e., selected and purchased from the Electronic Digital Content Store Web Site, by the user.

In response to this argument, the final Office Action argues that the "cited reference fairly suggest commanding the user location to store the content from the content

distributor without a user associated with the user location specifically requesting the content and sending the content to the user location for storage before a user specifically request the [content] wherein the content comprises at least one of a video program or an audio program." (Office Action page 3) In support of this argument, the Office Action cites Col. 3, lines 56-67 of Downs which altering the metadata (which is done by the Electronic Digital Content Store as described above) to form promotional data. As noted above, the metadata provides information about the content that can be used by an Electronic Digital Content Store to form promotional data for use on its website. However, the promotional data is not provided to the user's system until it is viewed by the user on the Electronic Digital Content Store website. Furthermore, under Downs, the content is downloaded to and stored at the user's location only after specifically requested, i.e., selected and purchased from the Electronic Digital Content Store Web Site, by the user.

Ellis also fails to teach or suggest, alone or in combination with Downs, storing content at a user location before the user specifically requests the content. More specifically, Ellis is directed to an interactive television program guide system having a main facility (e.g., a satellite uplink facility) that provides program guide data from a data source to a number of television distribution facilities (e.g., cable system headends, broadcast distribution facilities, satellite television distribution facilities, or any other suitable television distribution facilities)." (Col. 2, lines 31-37) "The program guide data transmitted by the main facility to the television distribution facilities includes television programming data (e.g., titles, channels, descriptions and content information, rating information, or any other information associated with television programming)." (Col. 2, lines 37-42) However, under Ellis, the content is not downloaded to or stored at the user's location until selected. Specifically, Ellis states "television distribution facility may supply programs to user television equipment **in response to demands made by the user using user television equipment.**" (Col. 7, lines 7-9, emphasis added) That is, like the promotional data of Downs, the program guide data of Ellis can be used by the user to select content. However, under both Downs and Ellis, the content is not downloaded to or stored at the user's location until **after** it is specifically selected by the user.

In response to this argument, the final Office Action continues to maintain that Ellis "fairly suggest receiving a command from the content distributor to store the content at the user location before a user specifically request the content wherein the content comprises at least one of a video program or audio program." (Office Action page 2) In support of this argument, the Office Action cites col. 2, line 64 - col. 3, line 17 of Ellis which recites in total:

"The interactive television program guide may store a language attribute identifying the selected language. A default program guide language attribute may also be stored by the program guide. The default program guide language attribute may, for example, be preprogrammed into the program guide or supplied as program guide data. Default program languages for individual programs may also be supplied as program guide data.

The program guide may also provide users with an opportunity to select an alternate language in which program guide display screen text is displayed and programming audio played. For example, the user may select Spanish as a primary language and English as an alternate language. In another suitable approach, the program guide may pick an alternate language based on the primary language selected by the user. If the user selects Canadian English for the primary language, for example, the program guide may select U.S. English as an alternate language. As used herein, "selected language" is intended to include a primary language selected by the user, a secondary language selected by the user or the program guide, or any suitable combination thereof.

The Office Action then goes on to conclude "therefore, the examiner interprets that by default program is given before users request so that user can choose from." (Office Action page 3) With all due respect, the Applicants cannot understand or agree with this conclusion. Rather, the Applicants contend that the language attribute, whether default or user selected, is not a video or audio program by any common meaning of the terms and especially in view of the rest of the disclosure of Ellis as described above. The language attribute described here is an attribute that defines the language in which the program guide text is presented and a selected television program is played. (Col. 2, lines 55-66) The language attribute thus cannot be considered to be content that comprises at least one video program or an audio program.

Therefore, the Applicants maintain that Ellis does not teach or suggest, alone or in combination with Ellis, storing content at a user location before the user specifically requests the content. Under both Downs and Ellis, the content is not downloaded to or stored at the user's location until **after** it is specifically selected by the user.

Claim 1, upon which claims 2, 4-7, and 21-22 depend, is directed to a method for distributing content sent by a content distributor to a user location. Claim 14, upon which claims 15 and 17-20 depend, is directed to a distribution program product having code for distributing content sent by a content distributor to a user location. Both claim 1 and claim 14 recite in part "receiving a command from the content distributor to store the content at the user location before a user specifically requests the content, wherein the content comprises a subset of content available from the content distributor, the subset associated with a premium subscription service, and wherein the content comprises at least one of a video program or an audio program." Neither Downs nor Ellis, alone or in combination, teaches or suggests storing content (i.e., a video program or an audio program) at a user location before the user specifically requests the content. Rather, both Downs and Ellis teach delivering content only after a user requests the content. Furthermore, neither reference, alone or in combination, teaches or suggests the content comprising a subset of content available from the content distributor and associated with a premium subscription service. For at least these reasons, the rejection is improper and claims 1-2, 4-7, 14-15, and 17-22 should be allowed.

Claim 8, upon which claims 9-13 depend, is directed to a method for distributing content sent by a content distributor to a user location and recites in part "determining a subset of content from a larger set of content available from the content distributor, wherein the subset of content is associated with a premium subscription service", "commanding the user location to store the content from the content distributor without a user associated with the user location specifically requesting the content", and "sending the content to the user location for storage before a user specifically requests the, wherein the content comprises at least one of a video

program or an audio program." Neither Downs nor Ellis, alone or in combination, teaches or suggests storing content (i.e., a video program or an audio program) at a user location before the user specifically requests the content. Rather, both Downs and Ellis teach delivering content only after a user requests the content. Furthermore, neither reference, alone or in combination, teaches or suggests the content comprising a subset of content available from the content distributor and associated with a premium subscription service. For at least these reasons, the rejection is improper and claims 8-13 should be allowed.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

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Respectfully submitted,

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